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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/581,074	05/31/2006	Markus Rosch	291261US0PCT	2085
22850 7590 03/03/2008 OBLON, SPIVAK, MCCLELLAND MAIER & NEUSTADT, P.C. 1940 DUKE STREET ALEXANDRIA, VA 22314				
EXAMINER CHANDRAKUMAR, NIZAL S				
ART UNIT 1625		PAPER NUMBER		
NOTIFICATION DATE 03/03/2008		DELIVERY MODE ELECTRONIC		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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Office Action Summary

Application No.

10/581,074

Applicant(s)

ROSCH ET AL.

Examiner

NIZAL S. CHANDRAKUMAR

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 08 January 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-23 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-23 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SF/ICE)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Applicants response filed 01/08/2008 is acknowledged.

Response to Applicants Remarks:

Claim Rejections - 35 USC § 112

Applicants amendments and arguments overcome the previously presented rejections under 35 USC § 112.

Claim Rejections - 35 USC § 103

Applicants persuasive arguments overcome the previously presented rejections under 35 USC § 103.

Double Patenting

Applicants arguments were fully considered and the previously presented double patenting rejection of claims 1-23 over the claims of US 7271299 (Hesse et al.) is maintained for the reasons of record.

Applicants argue that the limitations of the present claims,

and setting the ratio of the products, THF, GBL and BDO, relative to one another within the range from 10 to 100% by weight of THF, from 0 to 90% by weight of GBL and from 0 to 90% by weight of BDO only by varying the temperatures in the two hydrogenation reactors and also the GBL recycle stream.

are neither disclosed nor suggested by Hesse et al.

Hesse et al. discuss reaction parameters of hydrogenation such as pressure and temperature on the yields of the various products. Especially in column 10, line 47-62 Hesse et al teach that the ratio of THF, GBL, and BDO is a function of various temperatures.

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Optimizing reaction parameters such as temperature, pressure etc is within the routine nature in the practice of process development. For example, Bertola et al. (US 6248906) teaches, see column 2, lines 42-45 'pressure and temperature in the primary hydrogenation, as well as residence times on the catalyst can be optimized depending on the proportions between the GBL, THF to be produced" (see below).

"[W]here the general conditions of a claim are disclosed in the prior art, it is not inventive to discover the optimum or workable ranges by routine experimentation." *In re Aller*, 220 F.2d 454, 456, 105 USPQ 233, 235 (CCPA 1955).

New Rejections:

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Omum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1-23 rejected on the ground of nonstatutory obvious type double patenting over claims 1-30 of U. S. Patent No. 7154011 in view of Bertola et al. (US 6248906), since the claims, if allowed, would improperly extend the "right to exclude" already granted in the patent.

The subject matter claimed in the instant application is fully disclosed in the patent and is covered by the patent since the patent and the application are claiming common subject matter, as follows: The claims of the instant case and the claims of the issued patent are drawn to the hydrogenation of C4

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dicarboxylic acids and derivatives thereof, such as MA, in a two stage process using similar copper based catalyst, optionally removing the succinic anhydride if necessary, to produce various C4 products. The difference is that in the instant case, the claim limitation specifically mentions that the reaction parameter temperature is adjusted to vary the ratio of different products of hydrogenation.

In the case of the issued patent, the parameters are adjusted to the formation of BDL. However Hesse et al. also teach that the optimization of temperatures to obtain desired proportion of C4-hydrogenation products. Thus, in column 9, line 46-47, Hesse et al. teach that an important parameter is the maintenance of a suitable reaction temperature in both hydrogenation stages. In column 10, line 39-43, Hesse et al. teach the selectivity of ratio of the above products as a function of hydrogenation temperatures.

Optimization of reaction parameters to adjust the extent of hydrogenation and, simultaneous or subsequent thermal dehydration needed for cyclization to produce THF, are within the knowledge of one of ordinary skill in the art because Bertola et al. (US 6248906), (in a related process for the production of THF, GBL, BDL starting from MA esters, consisting of two subsequent hydrogenations) teaches, column 2, line 42-45, that "Pressure and temperature in the primary hydrogenation, as well as residence times on the catalyst can be optimized depending on the proportions between the GBL, THF to be produced".

One skilled in the art attempting to make THF would be motivated to optimize the reaction parameters such as pressure and temperature of the process of the issued patent, because it is well known in the art that the elimination the elements of water (from BDO and diol in general) is favored at higher temperatures; the process of the instant applications would have been suggested.

Furthermore, there is no apparent reason why applicant was prevented from presenting claims corresponding to those of the instant application during prosecution of the application which matured into a patent. See *In re Schneller*, 397 F.2d 350, 158 USPQ 210 (CCPA 1968). See also MPEP § 804.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to NIZAL S. CHANDRAKUMAR whose telephone number is (571)272-6202. The examiner can normally be reached on 8.30 AM - 4.30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Janet Andres can be reached on 571 0272-0867. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Nizal S. Chandrakumar

/D. Margaret Seaman/
Primary Examiner, Art Unit 1625